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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/729,630 | 12/05/2003 | Gregory W. Schad | DU-041-US-02 | 1113 |

7590 03/23/2005

H.B. Fuller
Patent Department
1200 Willow Lake Blvd.
P.O. Box 64683
St. Paul, MN 55164-0683

EXAMINER

ZIMMER, MARC S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1712

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/729,630 | SCHAD ET AL. | |
| | Examiner | Art Unit | |
| | Marc S. Zimmer | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is the Examiner's belief that fiber fillers are essential to the operability of Applicant's invention yet this aspect is not mentioned in any of these claims. Clarification is required.

Claim Analysis

Applicant claims a grout composition that is tintable at the point of sale. (In the Specification, it is explained that conventional grout compositions have a consistency that generally precludes the addition of pigments once the other components of the grout are combined.)

First, it should be recognized that the Examiner views the word "grout" as merely being a recitation of intended use and need not necessarily be mentioned by a reference for the claim to be anticipated. That being said, it is, nonetheless, appreciated that the prior art formulation should be capable of serving as a grout. Further, the fact that the compositions are tintable at a point of sale is, in the Examiner's estimation, merely indicative of a certain degree of workability in the composition upon mixing together all of its components, colorant aside of course. Hence, any grout composition for which it is implied that mixing can be done with some facility will read on at least claim 1.

Concerning the method claims, the Examiner does not view them to be especially limiting. Indeed, "providing.... upon request" could even refer to a employee in an industrial setting adding a tint to a grout composition upon being asked to do so by his foreman. Although the Examiner appreciates Applicant's intent, the claims simply don't read that narrowly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Speed, GB 1 572 906. Speed discloses "ready mixed" grouting compositions comprising a synthetic polymer, silicone oil, filler, and pigment. The fact that the grouting composition is characterized as being ready mixed would seem to indicate that it would be "tintable" at a point of sale. Method claim 8 is anticipated by the preparation approach outlined in the Examples.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Barker, U.S. patent # 3,859,233. Barker discloses a grout composition where the host matrix is a thermoplastic polymer (abstract). According to column 6, lines 62-67, these compositions are still highly workable even with high filler content hence they are inherently capable of being tinted at point of sale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speed, GB 1 572 906. Automated and manual dispensing apparatus alike are ubiquitous in manufacturing facilities thus claims 9 and 10 are obvious. Color fandecks and dispensers employing color matching software are used not only in retail outlets but also in experimental laboratories where tintable products are developed.

Allowable Subject Matter

Claims 2-3 and 6-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claims 13-15 are allowable. The prior art discloses neither a workable grout composition contain fiber fillers or silanated polymers. The method claims ostensibly could be made allowable if they were to be made dependent from an allowable product claim. Claims 13-15 are allowable insofar as there is no documented evidence that packaged articles comprising a grout composition and a colorant have been made available previously. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Other polymer grout compositions are disclosed in U.S. Patent Application Publication No. 2004/0134163 and JP 5-209109. It is not clear in either of these, however, that they could in fact, be tinted at point of sale as there is no mention of their consistency.

The art also teaches somewhat related products such as caulking formulations that may be tinted at a time following their original product. See, for example, U.S. Patent # 5,044,758 and U.S. patent Application Publication Nos. 2004/0173640 and 2002/0065353. However, in the Examiner's estimation, a caulking formulation could not employed in the same capacity as a grout-type composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Marc Zimmer
Marc Zimmer
AU 1712

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 19, 2005